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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,172

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Rainer Uecker

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SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER

FAN, HUA

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,172	<b>Applicant(s)</b> UECKER, RAINER	
	<b>Examiner</b> HUA FAN	<b>Art Unit</b> 4134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/30/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 "The network according to claim 29" cannot depend on itself. Appropriate correction is required. For the sake of examination, examiner assumes claim 29 depends on claim 28.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 16-22 and 24-30 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/20855 by Etsuo.

As to claim 16, Etsuo discloses a method for transmitting messages (figure 1 and 2, "mail") in a network (figure 1 and 2, component 100) via data terminals connected thereto (figure 1 and 2, components 200A, 200B, 200C, 200D, 300), comprising: sending a message to be relayed (abstract; page 9, paragraph 4) from a sender data terminal (figure 1 and 2, component 200B) to an assigned first mail processing device (figure 1 and 2, component 300); assigning a unique identifier to the message (figure 9 and 5(a), "Identifier"; page 21, paragraph 2-3) that indicates that a message to be

relayed is on the sender data terminal (identifier ID and PA, page 21, paragraph 2-3); evaluating the identifier by the first mail processing device based on data present therein concerning the entry of messages at an address data terminal from the past (abstract; page 9, paragraph 4 – page 10, paragraph 1); and triggering or blocking the transmission of the message or parts thereof to the address data terminal in response to the evaluation result (abstract; page 9, paragraph 4 – page 10, paragraph 1).

As to claim 17, Etsuo discloses the method according to claim 16, further comprising the following step after the step of assigning a unique identifier to the message that indicates that a message to be relayed is on the sender data terminal or in the first mail processing device and before the step of evaluating the identifier by the first mail processing device based on data present therein concerning the entry of messages at an address data terminal from the past, relaying the identifier to a second mail processing device that is assigned to an address data terminal for the message to be forwarded (page 21, paragraph 2-3, the disclosed mechanism can be performed on forwarded email in addition to emails sent from original sender).

As to claim 18, Etsue discloses the Method according to claim 17, wherein the data concerning the entry of messages in the address data terminal is stored in the first mail-processing device (page 9, paragraph 1 to page 10, paragraph 1, memory means in mail server; page 22, paragraph 5 – page 23, paragraph 1).

As to claim 19, Etsue discloses the method according to claim 17, wherein the data concerning the entry of messages in the address data terminal is stored in the

second mail-processing device (page 21, paragraph 2-3, the disclosed mechanism can be performed on forwarded email in addition to emails sent from original sender).

As to claim 20, Etsue discloses the method according to claim 17, wherein the first mail-processing device is implemented in the sender-data terminal (claim 2).

As to claim 21, Etsue discloses the method according to claim 17, wherein the identifier is evaluated on a mail server in the network (page 10, paragraph 1; figure 1).

As to claim 22, Etsue discloses the method according to claim 17, wherein the identifier consists of a plurality of subidentifiers (page 21, paragraph 2-3), each of which are assigned message elements (page 21, paragraph 2-3, e.g., original body, forwarded body; page 34, paragraph 2), with each subidentifier being evaluated in the respective mail processing device based on the data present therein concerning the entry of messages at the address data terminal from the past (page 35, paragraph 2 – page 36, paragraph 4), and with transmission of the respective message element being triggered or blocked in response to the evaluation result (page 36, paragraph 3-4).

As to claim 24, Etsue discloses the method according to claim 17, wherein the identifier and/or the relevant subidentifier indicates an e-mail address of an original sender if this differs from the e-mail address of the sender, and/or the contents of the message or of the respective message element (page 33, paragraph 4).

As to claim 25, Etsue discloses the method according to claim 17, wherein there is a data terminal for executing the method (claim 1-2 and 7) and having a mail processing device that is designed such that an identifier for a message based on data present concerning the entry of messages at an address data terminal from the past is

evaluated in an evaluation unit (claim 1-2 and 7), and such that, based on the evaluation result, transmission of a message to the address data terminal is triggered or blocked (claim 1-2 and 7).

As to claim 26, Etsue discloses the method according to claim 25, wherein the mail-processing device forms part of a mail server (claim 1), which is integrated in the data terminal (mail server can be used as data terminal as well since it is able to generating and receiving emails, page 22, paragraph 4).

As to claim 27, Etsue discloses the method according to claim 25, wherein a memory unit for storing data concerning the entry of messages at a different data terminal (mail server 300, page 22, paragraph 4 – page 23, paragraph 1).

As to claim 28, Etsue discloses a network, comprising: a method comprising; sending a message to be relayed (abstract; page 9, paragraph 4) from a sender data terminal (figure 1 and 2, component 200B) to an assigned first mail processing device (figure 1 and 2, component 300); assigning a unique identifier to the message (figure 9 and 5(a), “Identifier”; page 21, paragraph 2-3) that indicates that a message to be relayed is on the sender data terminal (identifier ID and PA, page 21, paragraph 2-3); relaying the identifier to a second mail processing device that is assigned to an address data terminal for the message to be forwarded (page 21, paragraph 2-3, the disclosed mechanism can be performed on forwarded email in addition to emails sent from original sender); evaluating the identifier by the first mail processing device based on data present therein concerning the entry of messages at an address data terminal from the past (abstract; page 9, paragraph 4 – page 10, paragraph 1); triggering or blocking

the transmission of the message or parts thereof to the address data terminal in response to the evaluation result (abstract; page 9, paragraph 4 – page 10, paragraph 1); and a mail processing device that is designed such that an identifier for a message is evaluated in an evaluation unit based on data present concerning the entry of messages at an address data terminal from the past (abstract; page 9, paragraph 4 – page 10, paragraph 1), and based on the evaluation result, transmission of a message to the address data terminal is triggered or blocked (abstract; page 9, paragraph 4 – page 10, paragraph 1).

As to claim 29, for the sake of examination, examiner assumes claim 29 depends on claim 28. See similar rejection to claim 26.

As to claim 30, Etsue discloses the network according to claim 29, wherein a memory unit for storing data concerning the entry of messages at connected data terminals (page 20, paragraph 4 – page 21, paragraph 1).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as unpatentable over WO 01/20855 by Etsuo., in view of JP 11232188 by Yoshihiro.

As to claim 23, Etsuo does not expressly disclose the method according to claim 17, wherein a notification of the blocked transmission is forwarded to the sender and/or recipient if the transmission is blocked on the basis of the evaluation result.

Yoshihiro discloses a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email (abstract).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the method disclosed by Etsuo with the method disclosed by Yoshihiro regarding a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email. The suggestion/motivation of the combination would have been to inform the originator that the predetermined title and predetermined message of the received E-mail are the same (Yoshihiro, [0020]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUA FAN whose telephone number is (571)270-5311. The examiner can normally be reached on M-F 7:30am-5pm EST.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lunyi Lao can be reached on (571) 272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. F./  
Examiner, Art Unit 4134

/LUN-YI LAO/  
Supervisory Patent Examiner, Art Unit 4134